

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD LENNIHAN

Appeal No. 2002-0480
Application 09/224,649

ON BRIEF

Before ABRAMS, STAAB, and MCQUADE, Administrative Patent Judges.
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Richard Lennihan appeals from the final rejection (Paper No. 20) of claims 1 through 9 and 11 through 14. Claims 19, 20, 23, 24, 26 and 27, the only other claims pending in the application, have been allowed by the examiner.

THE INVENTION

The invention relates to a shoe which, according to the appellant, "will make walking and running smoother, easier, more efficient, quicker, and simultaneously will reduce injuries arising from impact forces" (specification, page 1). A copy of

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appealed claims 1 through 9 and 11 through 14, as well as allowed claims 19, 20, 23, 24, 26 and 27, appears in the appendix to the appellant's brief (Paper No. 24).

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Pipes	2,124,986	Jul. 26, 1938
Craver	2,162,912	Jun. 20, 1939
Turner et al. (Turner)	4,364,188	Dec. 21, 1982
Parker et al. (Parker)	4,817,304	Apr. 4, 1989
Misevich et al. (Misevich)	4,956,927	Sep. 18, 1990
Anderie et al. (Anderie)	4,970,807	Nov. 20, 1990
Bacchiocchi	5,086,574	Feb. 11, 1992
Frachey et al. (Frachey '060)	5,092,060	Mar. 3, 1992
Sasaki et al. (Sasaki)	5,331,750	Jul. 26, 1994
Frachey et al. (Frachey '896)	5,369,896	Dec. 6, 1994
Fitchmun et al. (Fitchmun)	5,390,430	Feb. 21, 1995

THE REJECTIONS

Claims 1 and 11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Parker.

Claims 2 through 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parker in view of Craver or Pipes.

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Parker in view of Fitchmun.

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Claims 5 through 9, 12 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parker in view of Anderie or Sasaki.

Claims 5 through 9, 12 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parker in view of any one of Misevich, Turner, Frachey '060, Frachey '896, or Bacchiocchi.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 24 and 26) and to the examiner's answer (Paper No. 25) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.¹

DISCUSSION

I. The 35 U.S.C. § 102(b) rejection of claims 1 and 11

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

¹ In the final rejection (Paper No. 20), claims 20 and 26 stood rejected under 35 U.S.C. § 112, second paragraph, and under 35 U.S.C. § 103(a). The examiner withdrew these rejections and allowed the claims as a result of an amendment subsequent to final rejection (see Paper Nos. 21 and 22).

Parker discloses a running shoe 10 comprising a sole structure 12 and an upper 14. The sole structure includes a midsole 16, and outsole 18 and a compliant and resilient insert 20.

Independent claim 1 recites a shoe comprising, inter alia, a sole piece having a front section, a middle section, a rear section, a ground engaging bottom surface and an upper surface on which the user's foot is received, wherein

when said shoe is resting on a flat surface, said upper surface of the sole piece where the foot would rest would not be parallel to the flat surface and would have said rear section slightly higher in elevation than said front section of said sole piece so that when the user inserts the user's foot the toes of the user's foot face towards the flat surface and are not parallel with the flat surface.

In determining that Parker meets the foregoing limitations, the examiner finds that

[a]s can be clearly seen in Figure 1 of Parker, the sole of the shoe has a top surface that declines from the heel to the toe when the shoe is placed on a flat surface without the user's foot being placed in the shoe. Therefore, the placement of the user's foot within the shoe would have the toes facing the flat surface and not parallel with the flat surface, angling forward from the heel to the toes [answer, page 8].

Neither Figure 1 nor any other part of the Parker reference supports this finding. Even if Figure 1 does show Parker's shoe

in the orientation it would assume when resting on a flat surface, with the upper surface of its sole not parallel to the flat surface and the rear section of the sole slightly higher in elevation than the front section, there is simply nothing in this drawing figure which indicates that the sole is structured such that when the user inserts a foot into the shoe the toes of the foot would face towards and not be parallel with the flat surface as recited in claim 1. The examiner's assertion to the contrary is purely conjectural. Hence, Parker does not disclose each and every element of the shoe recited in claim 1.

Accordingly, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of independent claim 1, and dependent claim 11, as being anticipated by Parker.

II. The 35 U.S.C. § 103(a) rejections of claims 2 through 9 and 12 through 14

Claims 2 through 9 and 12 through 14 depend, directly or indirectly, from independent claim 1. In short, the secondary references applied by the examiner to support the rejections of these claims fail to overcome the foregoing deficiency of Parker with respect to the subject matter recited in parent claim 1.

Therefore, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 2 through 4 as being unpatentable

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over Parker in view of Craver or Pipes, the standing 35 U.S.C. § 103(a) rejection of claim 13 as being unpatentable over Parker in view of Fitchmun, the standing 35 U.S.C. § 103(a) rejection of claims 5 through 9, 12 and 14 as being unpatentable over Parker in view of Anderie or Sasaki, or the standing 35 U.S.C. § 103(a) rejection of claims 5 through 9, 12 and 14 as being unpatentable over Parker in view of any one of Misevich, Turner, Frachey '060, Frachey '896, or Bacchiocchi.

III. New ground of rejection

The following rejection is entered pursuant to 37 CFR § 1.196(b).

Appealed claims 1 through 9 and 11 through 14, and heretofore allowed claims 19, 20, 23, 24, 26 and 27, are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

The scope of independent claims 1, 19 and 27, and dependent claims 2 through 9, 11 through 14, 20, 23, 24 and 26, is unclear for the following reasons.

In claims 1 and 27, the recitations that the bottom surface of the sole piece has (1) a "smooth continuous surface" and (2) a

"single low point" are inconsistent in that the single low point would render the surface unsmooth. Based on the discussion of the single low point in the underlying specification, it would seem that the use of the term "point" to define the portion of the bottom surface in question is somewhat inaccurate. The same is true of the use of the term "point" to define the "contact point" recited in these claims.

Also in claims 1 and 27, the recitation that when the single low point is in contact with the flat surface the "entire" remaining bottom surface of the sole piece would be tilted upwardly from the rear section to the front section is inconsistent with the preceding recitation of the single low point as being forward of the back end of the rear section. If the single low point is forward of the back end of the rear section, the portion of the bottom surface to the rear of the single low point, which is part of the "entire" remaining bottom surface, is not accurately defined as being tilted upwardly from the rear section to the front section.

Furthermore, the recitation in claim 1 that when the shoe is resting on a flat surface the upper surface of the sole piece would not be parallel to the flat surface is inconsistent with the subsequent recitation that when the shoe is resting on a flat

surface the front end of the shoe is elevated such that the upper surface of the sole piece is parallel to the flat surface.

Additionally, the reference in claim 27 to the "inner sole" lacks a proper antecedent basis.

In claims 2 through 4, the recitation of the treads is inconsistent with the recitation in parent claim 1 that the bottom surface of the sole piece has a smooth continuous surface from the rear section to the front section.

In claim 2, the recitation that the tread of the transverse tread design lies transverse to the "width," rather than the length, of the sole piece along a longitudinal line of the sole does not make sense.

In claims 5, 6 and 9, it is unclear how the recited sole piece upper and lower ends relate to the previously recited sole piece upper and lower surfaces.

In claim 19, the double recitation of the sole piece upper surface on which the user's foot is received is redundant, and the terms "the upper sole piece" and "said upper end of said sole piece" lack a proper antecedent basis.

Finally, in claim 20, the term "said smooth continuous surface" lacks a proper antecedent basis, the recitation of such a surface is inconsistent with the accompanying recitation of the

tread design, and the definition of the tread of the transverse tread design as lying transverse to the "width," rather than the length, of the sole piece along a longitudinal line of the sole does not make sense.

SUMMARY

The decision of the examiner to reject claims 1 through 9 and 11 through 14 is reversed, and a new rejection of claims 1 through 9, 11 through 14, 19, 20, 23, 24, 26 and 27 is entered pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

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(2) Request that the application be reheard under
§ 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record. . . .

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED; 37 CFR § 1.196(b).

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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